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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/152,992	09/14/1998	RANDI LYNN SCHINDLER	05-10022	4868

36212 7590 08/23/2006

LAW OFFICES OF DAVID L. HOFFMAN
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VALENCIA, CA 91355

EXAMINER

BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/152,992	SCHINDLER, RANDI LYNN	
	Examiner	Art Unit	
	Michael Brown	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 13, 15, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-10-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodley in view of Montgomery.

Woodley discloses in figures 1-4 a nipple cover comprising a flexible material (latex), being in the shape of a hollow curve (the curved portion of 20 that the nipple fits into), having an inner surface (fig. 3), an outer surface (fig. 2), an adhesive 26, on the inner surface, the cover has a first thickness proximate the center that is greater than a second thickness around the periphery, providing a gradually tapering cover, the curvature of the outer surface is smooth, the cover is manufactured of a flexible plastic (latex), the nipple cover has a hollow hemisphere shape (fig. 2), the nipple cover covers the breast, , an absorbent pad 24, disposed on the inner surface, a plurality of holes 40 and the adhesive is reusable. However, it could be argued that Woodley doesn't disclose a hollow hemisphere shape nipple cover that has a substantially smooth inner surface and a substantially smooth outer surface. Montgomery teaches in figures 1-4 a nipple cover 5, manufactured from a flexible material (rubber), formed substantially in the shape of a hollow hemisphere, having a substantially smooth inner surface (fig. 3), a substantially smooth outer surface (fig. 3), a hollow hemisphere (fig. 3) and the cover is

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substantially thin (fig.3). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the nipple cover disclosed by Woodley could be fabricated as a hollow hemisphere shape having a substantially smooth inner and a substantially smooth outer surface as taught by Montgomery in order to allow the hemisphere shape to conform to the shape of the patient's breast. In figure 5, of Woodley the second thickness appears to be substantially less than one half of the first thickness proximate the center. The device is unitary formed between the inner and outer surface (fig. 1).

Claims 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodley in view of Morrissey, along with Lee.

Woodley discloses in figures 1-4 a nipple cover, as set forth above. Morrissey teaches in figures 1-5 a nipple cover 2, manufactured from a flexible material (plastic, col. 2, lines 57-60), being formed substantially in the shape of a hollow curved surface (convex surface), having an inner surface 3, an outer surface 5, substantially smooth (fig. 6), the cover has the shape of a hollow hemisphere (fig. 1), the cover is substantially thin (fig. 5), an absorbent pad 9, disposed on the inner surface (fig. 7) and a plurality of holes 4, disposed in the cover. However, neither reference teaches a set of nipple covers or the cover being different in shape or color. Lee teaches in figures 1-11 a breast prosthesis comprising a nipple cover 10 that can be tinted to match a patient skin color. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the nipple cover disclosed by Woodley and taught Montgomery could be fabricated of a skin color as taught by Lee in order to allow the

cover to blend in with the patient's skin color. It is simply a matter of duplication to make different sets of the nipple covers.

Allowable Subject Matter

Claims 11, 13, 15 and 21-22 are allowed.

Response to Arguments

Applicant's arguments filed May 31, 2006 have been fully considered but they are not persuasive. Applicant argues that Woodley only covers the nipple and the areola and the device is like a circular band aid that doesn't have a curve. However, Woodley was used to set forth the environment of a nipple cover having a curved body and a first thickness at the center and a second smaller thickness at the outer periphery. As for the device disclosed by Woodley covering the breast, some women have such small breast that even the device disclosed by Woodley would cover the breast. Applicant argues that one of ordinary skill in the art wouldn't have combine Woodley with Morrissey. However, all arguments pertaining to claims 1-8 and 12 are moot because the amendment to claim 1 necessitated a new rejection. As for claims 14 and 16-20 applicant argues that there is no teaching for combining Woodley with Morrissey. However, Woodley was used to set forth the environment of a nipple cover. Morrissey was used as a modifier to form the device disclosed by Woodley as being flexible, in the shape of a curve and being a hollow hemisphere shape. Clearly the prior art is used to perform a different function from the prior art, as indicated by the allowing of the method claims. However, since all the other claims are article/product claims, all the prior art has to do is be capable of performing the covering of a nipple. Applicant argues that

rubber-like material is normally more elastic than plastic. However, plastic is a rubber-like material. Applicant that Lee lacks a teaching of placing the device under a garment and not removing when the device if the garment is removed. However, Lee is capable of performing this function.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

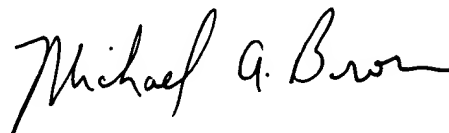
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gergory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Brown
August 21, 2006

A handwritten signature in black ink that reads "Michael A. Brown". The signature is written in a cursive, flowing style.

**MICHAEL A. BROWN
PRIMARY EXAMINER**